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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/700,148	12/04/2000	Klaus Peter Gerbling	101215-51	2125

7590 09/26/2002

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EXAMINER

EINSMANN, JULIET CAROLINE

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 09/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/700,148

Applicant(s)

GERBLING ET AL.

Examiner

Juliet C Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 12-15 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 12, in part, drawn to kits comprising probes and primers for *P. aeruginosa*.

Group II, claim(s) 12, in part, drawn to kits comprising probes and primers for *E. coli*.

Group III, claim(s) 12, in part, drawn to kits comprising probes and primers for *Salmonella*.

Group IV, claim(s) 12, in part, drawn to kits comprising probes and primers for bacteria.

Group V, claim(s) 12, in part, drawn to kits comprising probes and primers for enterobacteriaceae.

Group VI, claim(s) 12, in part, drawn to kits comprising probes and primers for enterobacteriaceae (16S rRNA).

Group VII, claim(s) 13, in part, drawn to methods for the detection of *P. aeruginosa*.

Group VIII, claim(s) 13, in part, drawn to methods for the detection of *E. coli*.

Group IX, claim(s) 13, in part, drawn to methods for the detection of salmonella.

Group X, claim(s) 13, in part, drawn to methods for the detection of bacteria.

Group XI, claim(s) 13, in part, drawn to methods for the detection of enterobacteriaceae.

Group XII, claim(s) 13, in part, drawn to methods for the detection of enterobacteriaceae (16S rRNA).

Group XIII, claim(s) 15-23, drawn to kits comprising probes and primers for *S. aureus*.

Group XIV, claim(s) 24-25, drawn to methods for the detection of *S. aureus*.

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2. The inventions listed as Groups I-XIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The feature that joins the named inventions is the fact that they comprise or utilize probes and primers for the detection of bacteria. However, such a feature is not a special technical feature in view of the prior art, since the prior art provides kits and methods which comprise and utilize probes and primers for the detection of bacterial species. For example, Matsunaga et al. (US 5702895) provide a kit comprising nucleic acid primers for the detection of *S. aureus*, and methods for using these kits (see abstract and claims). Thus, the technical feature that joins these groups is not a "special technical feature" in accord with the PCT rules.

In light of the fact that there is no special technical feature which joins all of the claims, the claims have been divided into groups according to the organism whose genome the particular probes and primers are designed to hybridize to and according to the organism that is being detected in the recited methods.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet C. Einsmann whose telephone number is (703) 306-5824. The examiner can normally be reached on Monday through Friday, from 9:00 AM until 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Juliet C. Einsmann  
Examiner  
Art Unit 1634

September 23, 2002



W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600